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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/187,623 01/25/94 LEYBA

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EXAMINER
MCDONALD, C

B4M1/0523

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ART UNIT	PAPER NUMBER
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2401

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DATE MAILED: 05/23/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-14 are pending in the application.
Of the above, claims 12-14 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-11 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-11, drawn to a golf bag, classified in Class 206, subclass 315.5.

Group II. Claims 12-14, drawn to a method of applying indicia to a golf bag, classified in Class 493, subclass 187.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as without applying indicia.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr Sokoloff on May 3, 1994 a provisional election was made without traverse to prosecute the invention of the golf bag, claims 1-11.

Affirmation of this election must be made by applicant in

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responding to this Office action. Claims 12-14 withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gerber.

Gerber discloses a single panel(34R) which forms a compartment and is removable coupled to the golf bag by T-shaped mating fasteners.

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in

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section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9. Claims 6 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Gerber in view of Yamazoe.

Gerber discloses the invention as claimed except for the use of a water resistant and padded material. Yamazoe discloses a golf bag which has pockets made from a waterproof material and padding (see fig. 5). It would have been obvious to use waterproof material and padding with the pockets of Gerber motivated by Yamazoe's teaching of the protection the material gives to the pocket's contents.

10. Claims 9 and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over Gerber in view of Miller.

Gerber discloses a golf bag with a removable compartment. Gerber does not disclose a compartment that is attached by a circumferential zipper. Miller discloses a compartment that can be added to a bag that is attached by a circumferential zipper. It would have been obvious to use a panel with a circumferential

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zipper to make the compartment of Gerber motivated by Millers teaching of the ease in adding and removing the compartment.


11. Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over the prior art as applied to claims 9 and 10 above, and further in view of Brown.

The combination does not disclose the use of a lateral opening in the compartment. Brown discloses removable compartments for a golf bag that have lateral openings. It would have been obvious to use lateral openings with the compartments of Gerber motivated by Brown teaching of the easy access to the compartment's contents.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Takayama and Wilson disclose compartments attached by zippers. Perrin et al. discloses a removable compartment on a golf bag that is attached by a zipper (see fig. 4).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris McDonald whose telephone number is (703) 308-1038.


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SUPERVISORY PATENT EXAMINER
GROUP 2400


CJM
May 12, 1994

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